

REMARKS

Claims 5-10 remain pending, and claims 2-4 are canceled via the present submission. No claims are currently amended or added.

Claim 6 stands rejected under 35 U.S.C. § 102(e) as anticipated by Takada et al., U.S. Patent Application Publication No. 2003/0224672. Applicants respectfully traverse this rejection for multiple reasons.

First, claim 6 describes a shift mechanism that includes:

a shock mitigator mitigating shock generated during the shift.

To justify relying on Takada et al. to anticipate this element, the Office Action cites paragraph [0057] (without further explanation). However, the cited text does not disclose a shock mitigator as claimed.

Applicants acknowledge that the cited paragraph recites the word “mitigate,” but this word is used to describe a feature of electric motor 42. Specifically, the paragraph explains that electric motor 42 drives or rotates shift rod 90, which can mitigate *the load*, that is, reduce the load from what it would have been under manual operation. Takada et al. discloses that the addition of electric motor 42 can offer improved operation feel.

The Office Action quotes no discussion in paragraph [0057] of mitigating “shock” as claimed, that is, during shifting. Thus, the Office Action does not explain how Takada et al. supposedly teaches this claim feature. Accordingly, the rejection is improper for at least this reason.

Claim 6 also describes the shift mechanism as having:

a *case* accommodating the actuator and the reduction-gear mechanism as a unit *at a position immediately above the shift rod (emphasis added)*.

The rejection relies on gear case 82 to teach this element. However, gear case 82 is not the type of case described in the claim for the following reason:

First, to anticipate the “actuator” and “shift rod” recited in the claim, the rejection relies on electric motor 42 and shift rod 90, respectively. Also, gear case 82 is a major part of the exterior of outboard motor 10. Gear case 82 houses propeller shaft 84, and rudder 23 is formed integrally with gear case 82. (See paragraph [0043].) Figs. 3 and 4 show that gear case 82 extends from the bottom of rudder 23 to the top of electric motor 42. The figures also show that gear case 82 encases shift rod 90.

Therefore, gear case 82 cannot anticipate a case at a position above a shift rod as claimed, even if *part* of gear case 82 extends higher than shift rod 90. The claim requirement that the case be positioned *above* the shift rod cannot be reasonably interpreted to cover a case that entirely encases the shift rod. (Fig. 17 of applicants’ disclosure shows as example of the claimed configuration. Case 90 accommodates an actuator, electric motor 50, and a reduction-gear mechanism (connected to output shaft 92os) at a position immediately above shift rod 80. Such a configuration can decrease the distance between shift rod 80 and electric motor 50, can make the structure simple, and can avoid an increase in the number of components and weight, while preventing a problem regarding space utilization. Note applicants’ specification, page 18, lines 17-23.)

Because gear case 82 is not positioned above a shift rod as claimed, the rejection is improper for a second reason.

Additionally, Takada et al., made public on December 4, 2003, was filed (in the U.S.) on May 29, 2003. Although these dates are before the U.S. filing date of the present application,

applicants claim foreign priority dates of January 17, 2003 and February 14, 2003, which precede the dates of Takada et al.

Applicants perfect the foreign priority date using the procedure described in MPEP § 201.15. That is, applicants enclose a verified English language translation of Japanese Patent Application 2003-010048, which includes description that supports claims 6-8. (Accordingly, it is not necessary to provide verified English language translations of the other priority applications.) Thus, the rejection is overcome.

In view of the preceding discussion, applicants now solicit the withdrawal of the anticipation rejection of claim 6.

Claims 2-4 stand rejected under 35 U.S.C. § 103(a) as obvious over Suzuki et al., JP 59-073627, in view of Kawai et al., U.S. Patent No. 5,147,231. As shown above, these claims are now canceled, thereby rendering the rejection moot.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as obvious over Takada et al. in view of Suzuki et al., JP 59-073627. Applicants respectfully traverse this rejection.

Above, applicants explain that Takada et al. cannot anticipate claim 6, because Takada et al. does not teach a “shock mitigator” and a “case” as described in the claim. Applicants also overcome the anticipation rejection by perfecting the foreign priority date.

Further, the Office Action provides no explanation to address the absence of a case, as claimed, in Takada et al. Instead, the Office Action only explains why Suzuki et al. suggests modifying the assembly of Takada et al. to have a shock mitigator as claimed.

In applicants own review of Suzuki et al., they find no motivation for modifying the assembly of Takada et al. to have a case as described in the claim. Accordingly, the obviousness rejection is unjustified.

In view of this discussion, applicants solicit the withdrawal of the obviousness rejection of claim 6.

Applicants appreciate the allowance of claims 5, 9, and 10.


Applicants also appreciate the indication that claims 7 and 8 would be allowable, if claim 7 were rewritten in independent form. However, claims 7 and 8 depend from claim 6, and applicants explain above why the anticipation rejection and the obviousness rejection of claim 6 are improper. Accordingly, it is not necessary to rewrite claim 7 to gain the allowance of claims 7 and 8.

In view of the remarks above, applicants now submit that the application is in condition for allowance. Accordingly, a Notice of Allowability is hereby requested. If for any reason it is believed that this application is not now in condition for allowance, the Examiner is welcome to contact applicants' undersigned attorney at the telephone number indicated below to discuss resolution of the remaining issues.

If this paper is not timely filed, applicants petition for an extension of time. The fee for the extension, and any other fees that may be due, may be debited from Deposit Account No. 50-2866.

Respectfully submitted,

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Enclosure: Verified translation of Japanese patent application 2003-010048

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